UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/798,016 | 03/10/2004 | Tammy Ha | FALLS-68055 | 4939 |

24201 7590 06/13/2005

FULWIDER PATTON LEE & UTECHT, LLP
HOWARD HUGHES CENTER
6060 CENTER DRIVE
TENTH FLOOR
LOS ANGELES, CA 90045

| EXAMINER | |
|---|---|
| MCCORMICK EWOLDT, SUSAN BETH | |
| **ART UNIT** | **PAPER NUMBER** |
| 1654 | |

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/798,016 | HA, TAMMY | |
| | Examiner | Art Unit | |
| | Susan B. McCormick-Ewoldt | 1654 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *14 April 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) *5 and 10* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4 and 6-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

*Election/Restrictions*

Applicant's election without traverse of Group I in the reply filed on April 14, 2005 is acknowledged.

Applicant's election of Group in the reply filed on April 14, 2005 is acknowledged. Because Applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 5 and 10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 14, 2005.

*Claims Pending*

Claims 1-4 and 6-9 will be examined on the merits.

*Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 and 6-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

In claims 1 and 6 the terms "Macrocytis Pyrifera," "Ceratonia Silaqual" and "Hespridin Methyl Chalcone" appear to be misspelled. Clarification is needed.

Claim 6 states that it "further" consists of. This is confusing because the use of "further" implies that something has been added but nothing has been added. Clarification is needed.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hyldgaard *et al.* (US 6,342,208 B1), Yokoyama *et al.* (US 6,419,962 B1), Dalko *et al.* (US 6,846,812 B2) and Robinson *et al.* (2003/0049212 A1).

Hyldgaard *et al.* (US 6,342,208 B1) disclose using wheat gluten (column 8, line 54), humectants (column 18, line 42), hesperidin methyl chalcone (column 19, line 15) and emulsifiers (columns 9-12). In addition, Hyldgaard *et al.* disclose the composition is used for cosmetically acceptable composition that can be used for cleaning and moisturizing the skin (column 3, lines 1-25). Hyldgaard *et al.* does not disclose using *Cretonia siliqua*, acetyl hexapeptide-3, *Macrocystis pyrifera,* Dipepetide-2, Palmitoyl tetrapeptide-3 and Palmitoyl pentapeptides or the types of topical formulations.

Yokoyama *et al.* (US 6,419,962 B1) disclose using a carob (i.e. *Ceratonia siliqua*) in an external skin treatment which may used in cosmetics such as facial cleansers, beauty liquids and other basic cosmetic (column 8, lines 38-40; column 6, lines 11-20).

Dalko *et al.* (US 6,846,812 B2) disclose using *Macrocystis pyrifera,* Palmitoyl pentapeptide and alpha-hexapeptide-3 (which is also known as argireline) in a composition for improving the appearance of fine lines and wrinkles in the skin (abstract and column 9, lines 46-47, 62; column 10, lines 22-26, 54-59).

Robinson *et al.* (2003/0049212 A1) disclose the use of various peptides that are used in a topical skin care composition ([0026], [0052]). In addition water is used in the composition ([0133] and [0134]). Robinson *et al.* also disclose the type of formulations to be used in the composition ([0334], [0138]).

These references show that it was well known in the art at the time of the invention to use the claimed ingredients in compositions to improve the skin's appearance. It is well known that it is *prima facie* obvious to combine two or more ingredients each of which is taught by the prior

art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. *In re* Pinten, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); *In re* Susi, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); *In re* Crockett, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960).

Based on the disclosure by these references that these substances are used in compositions to improve the skin's appearance, an artisan of ordinary skill would have a reasonable expectation that a combination of the substances would also be useful in creating compositions to treat improve the skin's appearance. Therefore, the artisan would have been motivated to combine the claimed ingredients into a single composition. No patentable invention resides in combining old ingredients of known properties where the results obtained thereby are no more than the additive effect of the ingredients. See *In re* Sussman, 1943 C.D. 518; *In re* Huellmantel 139 USPQ 496; *In re* Crockett 126 USPQ 186.

It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re* Aller, 220 F2d 454, 456, 105 USPQ 233; 235 (CCPA 1955). See MPEP § 2144.05 part II. Variations of components in cosmetic compositions were well known in the art. It would have been obvious to one of ordinary skill in the art at the time Applicants' invention was made to determine all operable and optimal concentrations of components because concentration is an art-recognized result-effective variable that would have been routinely determined and optimized in the cosmetic art. Further, one of ordinary skill in the art would have been motivated to have modified the proportions of active ingredients in the composition in order to enable the content of the preparation to be matched with the demands and needs of individuals. Such variations in amounts of cosmetically active ingredients are considered merely optimization of result-effective variables, conventional practice in the art of skin care or cosmetology.

The references taken together teach the claimed ingredients can be used in a composition which is applied to the skin topically to improve the skin from fine lines and wrinkles. Therefore, a person of ordinary skill in the art would reasonably expect that the ingredients used in the references would be applied to a topically applied skin composition. Based on this reasonable

expectation of success, a person of ordinary skill in the art would be motivated to make modify the teachings of the references.

*Summary*

No claim is allowed.

Claims 6-9 are free of the art.

*Correspondence*

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick-Ewoldt whose telephone number is (571) 272-0981. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (571) 272-0974. The official fax number for the group is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sbme

Susan D. Coe
6-9-05
SUSAN COE
PRIMARY EXAMINER